

REMARKS

Claims 14-24 and 26 are pending in the present application. In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

I. Drawing Objection

In response to the Examiner's objection to Fig. 1, Applicants have amended Fig. 1 of the Replacement Sheet filed with the Preliminary Amendment of 4/10/06, by adding the legend "Prior Art."

II. Information Disclosure Statement

The Examiner has objected to the Information Disclosure Statements filed on 4/10/06, 11/26/08 and 4/23/09 because "some references in IDS do not have legible copies." Since the Examiner has never identified which specific references are missing legible copies, it is impossible for Applicants to comply with the Examiner's request. Once the Examiner identifies which references are missing legible copies, Applicants will submit the identified legible copies of the cited references.

III. Rejection of Claim 18 under §112

Claim 18 was rejected under U.S.C. §112, second paragraph, as being indefinite because "it is unclear whether the bevels refer to at least a first bevel or a second bevel." This rejection does not make any sense since (i) "bevels" logically refer to multiple items and (ii) there are only two "bevel" items in parent claim 15, which means "bevels" in claim 18 must refer to both the "first bevel" and the "second bevel" recited in parent claim 15. In any case, in order to expedite prosecution, claim 18 has been amended to explicitly recite that the first and second bevels allow for the diode to be pressed into the rectifier. Removal of the rejection is respectfully requested.

IV. Rejection of Claims 15, 16, and 26 under §102

Claims 15, 16, and 26 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,060,776 ("Spitz"). Applicants respectfully submit that this rejection should be reversed for at least the following reasons.

In order to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter of the claims. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Claim 15 has been amended to recite that “a clearance is provided between the sleeve of the plastic sheathing and an upper area of the base, the clearance preventing contact between the sleeve and an outer edge of the upper area of the base.” The present application clearly distinguishes between the trench (reference item 9 in the drawings of the present application), which is situated between the pedestal (reference item 8) and the sleeve (reference item 2), and a clearance (reference item ‘A’) situated between the sleeve and an upper area of the base. (See Replacement Drawings, Figure 2). The Spitz reference discusses and shows a trench (reference item 10 in Spitz) between the sleeve (Spitz reference item 12) and the pedestal of the base (Spitz reference item 3), but does not disclose or suggest a clearance between the sleeve and the bulwark (the upper area of the base, Spitz reference item 9, Figure 1), let alone disclose or suggest the presence of a clearance which prevents contact between the sleeve and an outer edge of the base. As clearly explained in the present application, the presence of the clearance prevents forces from being produced on the casting from deformation of the edges during press-fitting. (See Substitute Specification, Page 7, lines 15-18). Therefore, the Spitz reference does not disclose or suggest this claimed feature.

For the foregoing reasons, claim 15 and its dependant claim 16 and 26 are allowable over the Spitz reference. Removal of the anticipation rejection is requested.

V. Rejection of Claims 17-24 under §103

Claims 17-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Spitz. Applicants respectfully submit that this rejection should be reversed for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). In addition, all the teachings of the prior art must be considered, including those which teach away from the claimed invention. (See M.P.E.P. 2143.01.II). To the extent that the Examiner may be relying on the doctrine of inherent disclosure to support the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claims 17-24 depend from claim 15, and therefore claims 17-24 are allowable for essentially the same reasons as claim 15. As stated above, Spitz does not disclose or suggest the presence of a clearance between the sleeve and an upper area of the base, the clearance preventing contact between the sleeve and an outer edge of the upper area of the base, as recited in parent claim 15. Accordingly, by virtue of dependence of claims 17-24 on

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claim 15, Applicants submit that claims 17-24 are not rendered obvious by Spitz, and the obviousness rejection should be withdrawn.

CONCLUSION

In view of the above, it is respectfully submitted that all of the presently pending claims 14-24 and 26 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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